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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/121,300	07/23/1998	BRUCE G. KANIA	3295-0024-0C	3160
22850	7590	09/20/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 09/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/121,300

Applicant(s)

KANIA ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-78, 80, 85, 86, 88, 89, 92-94, 96, 99, 102, 103, 106, 107, 110, 111, 114, 115 and 118-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/4/2004
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 75-78,80,85,86,88,89,92-94,96,99,102,103,106,107,110,111,114,115 and 118-121.

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In the Information Disclosure Statement of June 4, 2004, the non-English language references were **not** considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) was not presented.

The Declaration under 37 CFR § 1.132 filed June 15, 2004, is insufficient to overcome the rejection of the current claims based upon 35 U.S.C. 112, first paragraph, as set forth in the last Office action for reasons set forth below.

Claim 86 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 86 depends from a canceled claim.

Claims 75-78, 80, 85, 86, 88, 89, 92-94, 96, 99, 102, 103, 106, 107, 110, 111, 114, 115, and 118-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The term "nonporous" or "non-porosity" is nowhere to be found in the original disclosure, and the Applicant has not provided any evidence that such a feature would have been gleaned from the examples at pages 29-32 or elsewhere in the specification by the ordinary practitioner. In fact, many of the originally disclosed embodiments involve *foamed* cushioning materials, as seen from the discussion on page 14, lines 6-19. The newly added language "substantially nonporous to air and water" (e.g., claim 75, last line) is likewise not supported by the original disclosure. Because of the procedure outlined in M.P.E.P. 2163.06 for interpreting the claims, it is noted that

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prior art may be applicable under 35 U.S.C. 102 or 35 U.S.C. 103(a) once the aforementioned problem under 35 U.S.C. 112, first paragraph, is corrected.

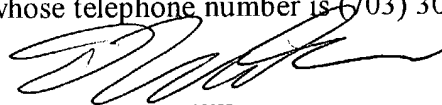
The Applicant describes the presently claimed cushion liner as being “counterintuitive” (Declaration under 37 CFR § 1.132: second page, line 10) and “unexpected”, and “notes that the Office’s initial reaction is as expected” (Amendment and Request for Reconsideration of June 4, 2004: page 9, line 17; emphasis in original). If this were so, then there would have been even greater reason to explicitly describe the “nonporous” and “substantially nonporous” features in the original disclosure. The Applicant’s remarks suggest that porous liners can generate “irritating and/or embarrassing noises” (*ibidem*: paragraph bridging pages 9 and 10), yet the Applicant’s original disclosure indicates that such problems are associated with socks which do **not** breathe (US 5,830,237: column 1, lines 48-62). The Applicant’s remarks and Declaration ignore other issues raised by the examiner (e.g., Office action mailed April 14, 2004: page 3, lines 10-12) and fail to make any particular reference to the original disclosure in support of the purported nonporous liner. The Applicant has thus not met the burden to present persuasive arguments satisfying the criteria set forth in MPEP 716.09.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903, and as of November 2, 2004, will be (571) 272-4762. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
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